

**REMARKS**

By this amendment, Applicants amend claims 50-54, 69, 76, and 86. Claims 18-22, 50-54, 69, 76, 79, and 86 remain pending in this application.

In the Office Action<sup>1</sup>, the Examiner took the following actions:

objected to the specification;

rejected claims 50-54, 69, 76, and 86 under 35 U.S.C. § 101;  
and

rejected claims 18-22, 50-54, 69, 76, 79, and 86 under 35 U.S.C. § 103(a) as being unpatentable over King et al. (U.S. Patent Application Publication No. 2002/0002590) in view of Whitehouse (U.S. Patent No. 5,341,505).

**I. Objection to the Specification**

Applicants respectfully traverse the objection to the specification as allegedly failing to provide proper antecedent basis for the claimed subject matter. The Office Action alleges that “[t]he specification is silent as to any clear hardware embodiments.” Office Action at page 3. Applicant disagree and note that some of the originally filed claims recite a “computer usable medium” and the drawings depict the systems that execute the claimed modules and components. For example, Figure 6 shows registration system 506, which includes an application server 602, a web server 604, and a database server 606. Registration system 506 further includes an ICRS database 608 and components of registration system 506 can communicate via network 504. One of ordinary skill in the art, when reading the claims in view of the specification, would understand that computers or servers facilitate implementation of

---

<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

the various disclosed embodiments. Accordingly, Applicants submit that the specification does provide proper antecedent basis for the claimed subject and respectfully request the Examiner to reconsider and withdraw the objection.

## **II. Rejection under 35 U.S.C. § 101**

Although Applicants respectfully traverse the rejection of claims 50-54, 69, 76, and 86 under 35 U.S.C. § 101, Applicants have amended claims 50-54, 69, 76, and 86. Accordingly, Applicants submit that the claims define statutory subject matter and request the Examiner to reconsider and withdraw the rejection.

## **III. Rejection under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 18-22, 50-54, 69, 76, 79, and 86 under 35 U.S.C. § 103(a) as being unpatentable over King in view of Whitehouse. A *prima facie* case of obviousness has not been established for at least the following reasons.

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements. M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008)(internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the

prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 18 recites, in part, “receiving the message directed to the user with the electronic account, where the message includes an electronic address associated with the user’s electronic account and a non-standardized physical address of the user, and wherein the non-standardized physical address includes a physical street address, a city name, a state name, and a 5-digit ZIP code.”

The Office Action states that, according to King, a “sender can enter the recipient’s electronic address (page 2, para 18; top) or can use a physical address to route the message to the user’s corresponding mailbox (page 2, para 19)” (emphasis added). Office Action at page 10. That is, the Office Action appears to admit that King discloses that a sender can enter an electronic address to directly send an electronic message or can enter a physical address to route an electronic message to a recipient. Applicants submit that King, however, does not teach or suggest including both an electronic address and a non-standardized physical address in the same message and, moreover, such a teaching is counter to the purpose of King.

According to the King system, a sender manually enters a physical address of a recipient or chooses a physical address of the recipient. King, paragraph [0018]. If the sender does not know the recipient’s physical address, then the physical address can be determined by “searching based on the recipient’s telephone number, zip code, state, or by any other information that is useful in the event that the sender does not know the physical address of the recipient.” Id. at paragraph [0022]. Alternatively, the

sender can enter “a conventional e-mail address to send a message or to send a carbon copy of the message” (emphasis added). Id. at paragraph [0018]. That is, in one alternative, a user supplies an electronic address and the message is sent electronically to the electronic address and, in a second alternative, a user supplies a physical address and an electronic message is sent. However, nothing in King teaches or suggests Applicants' claimed “message,” which includes “**an electronic address associated with the user's electronic account and a non-standardized physical address of the user . . . [that] includes a physical street address, a city name, a state name, and a 5-digit ZIP code,**” as recited in independent claim 18 (emphases added).

The contention in the Office Action that King discloses both an electronic address and a non-standardized physical address in the same message is counter to the teachings of King. In particular, King discloses:

[i]f the sender knows the physical address of the recipient Santa, the recipient can manually enter the address in the address line of the e-mail software application (e.g. Groupwise.RTM., Microsoft Mail.RTM.). In such a situation, the sender enters "123 North Pole Lane, NorthPole, U.S.A." The e-mail server then receives the e-mail and determines that that particular e-mail should be routed to Santa's electronic in-box located on an e-mail server.

King, paragraph [0019].

That is, the very purpose of the King system is that it receives an email including a physical address and determines an electronic in-box for the email. *See also* Abstract of King (“The present invention is a system and method for routing e-mails based on the recipient's physical address.”). If the message includes an electronic address, then the message can be sent electronically without further information. Accordingly, while King

teaches a message having a physical address, the message does not include an e-mail address **and** a non-standardized physical address. Moreover, nothing in King teaches or suggests that the physical address supplied in King constitutes Applicants' claimed "non-standardized physical address," which includes "a physical street address, a city name, a state name, and a 5-digit ZIP code." Therefore, King does not teach or suggest Applicants' claimed "message," which includes "**an electronic address** associated with the user's electronic account **and a non-standardized physical address** of the user . . . [that] **includes a physical street address, a city name, a state name, and a 5-digit ZIP code,**" as recited in independent claim 18 (emphases added).

Whitehouse does not overcome the deficiencies of King. That is, Whitehouse also does not teach or suggest Applicants' claimed "message," which includes "**an electronic address** associated with the user's electronic account **and a non-standardized physical address** of the user . . . [that] **includes a physical street address, a city name, a state name, and a 5-digit ZIP code,**" as recited in independent claim 18 (emphases added).

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Moreover, there is no teaching in the references which would motivate one of ordinary skill in the art to modify the disclosures thereof to achieve the claimed combination. Consequently, the Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been

established for at least the reasons discussed above and the Examiner should withdraw the rejection of independent claim 18 under 35 U.S.C. § 103(a).

Independent claims 50, 69, 76, 79, and 86, although of a different scope from each other and claim 18, each include recitations that are similar to claim 18. Accordingly, a *prima facie* case of obviousness has not been established for claims 50, 69, 76, 79, and 86 for at least the same reasons discussed above. Therefore, for at least the above reasons, the Examiner should also withdraw the rejection of claims 50, 69, 76, 79, and 86 under 35 U.S.C. § 103(a).

Dependent claims 19-22 and 51-54 depend from one of allowable independent claims 18 and 50, and are allowable at least due to their dependence. Accordingly, the Examiner should also withdraw the rejection of dependent claims 19-22 and 51-54 under 35 U.S.C. § 103(a).

**CONCLUSION**

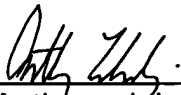
Applicants respectfully request reconsideration of the application, withdrawal of the claim rejections, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: December 23, 2008

By:   
\_\_\_\_\_  
Anthony J. Lombardi  
Reg. No. 53,232